REMARKS

Reconsideration of the application is requested in view of the amendments to the claims and the remarks presented herein.

The claims in the application are claims 1, 3 and 5, all other claims being cancelled.

All the claims were rejected under 35 U.S.C. 102 as being anticipated by Chapaton et al patent since the Examiner was of the opinion that compounds of a broader range than applicants'argument and still read upon the claims.

Applicants respectfully traverse this ground of rejection since Chapaton does not anticipate or render obvious Applicants'amended claims. The meaning of x in the -(CH2)x- moiety of the carboxylic acid group was further restricted to x = 7, 8 and 10. The generic formula (1) in Chapaton (column 3, lines 10) teaches, that the index z in the alkylene chain of the carboxylic acid moiety has a maximum figure of 4. Hence, ester compounds, in which x = 7 (derived from azeleic acid), x = 8 (derived from sebacic acid (x = 8) and x = 10 (derived from 1, 12-dodecanedioic acid) are not covered by the generic formula I, disclosed in column 3, lines 10 of Chapaton. If R3 means -(CH2)- in formula I, then the maximum index z could be 4, which means that the dicarboxylic acid would be adipic acid.

However, esters of the adipic acid and lower esters are now excluded from the scope of the amended Claim 1 and the further amended Claim 1 covers ester compounds, which are not anticipated by Chapaton. The declaration filed by the inventor refers to the viscosity and pour point data of the azeleic acid (x = 7) and sebacic acid (x = 8) and said compounds are not within the scope of the generic claim of Chapaton. The Examiner's statement at the top of page 3 of his Office Action (lines 2-3) is not quite correct with this respect. Moreover, Applicants'compounds possess the advantageous properties shown in the declaration filed with the last amendment and therefore, withdrawal of this ground of rejection is requested.

All the claims were rejected under 35 U.S.C. 103 as being obvious over the Brannock patent which the Examiner deems differs from the claimed compounds by a methyl substituent on the norbornane ring. The Examiner deems that the low viscosity and pour point data was not supported in the specification and that the declaration did not demonstrate patentable properties.

Applicants respectfully traverse this ground of rejection as the Brannock patent does not render obvious Applicants'invention since the patent gives no hint for replacing the 2-methyl-norbornane moiety with Applicants'unsubstituted norbornane moiety. Brannock clearly teaches, that the alcohol component of the ester compound is prepared by a Diels-Alder-reaction of methyl methacrylate with cyclopentadiene and the subsequent hydrogenolysis over a copper chromite catalyst (column 2, lines 3-5). Further, Brannock was published November 10, 1959 and the present application claims

a priority of April 15, 2003. Despite Brannock is known for 40 years, no art was published before the priority date of the instant application which discloses ester compounds with the un-substituted norbornane moiety. Therefore, the modification of the 2-methyl-norbornane moiety into the un-substituted norbornane moiety cannot be regarded as obvious.

Further, the Examiner argues, that the properties, that are disclosed in the declaration are not supported by the specification. However, as disclosed on page 8, lines 3-5, the inventive esters can be used as plasticizers for thermoplastic polymers and as lubricants with excellent results. Then the Examiner cited Brannock and in view of said art, the Applicant filed the declaration in order to demonstrate, that the inventive ester compounds are superior over the compounds known from Brannock. The viscosity and pour point data disclosed in said declaration clearly reveal, that the inventive ester compounds based on the un-substituted norbornane moiety exhibit a far more lower pour point of -48°C or even below -48°C compared to the Brannock esters of -40°C. A difference of -8°C means a substantial improvement in the behaviour in low temperature applications. The Examiner argues, that there is an overlap between the pour points. This might be true for applications in an average low temperature area. However, in critical low temperature applications, a lubricant based on the inventive ester compound with a pour point of -48°C could provide a far more improved performance than a lubricant, which is based on an ester compound having a pour point of -40°C.

Hence, the Applicant is the opinion, that the inventive ester compounds provide a substantial improvement over the ester compounds known from Brannock and can not be regarded as an obvious alternative in view of the Brannock esters. Therefore, withdrawal of this ground of rejection is requested.

In view of the amendment to the claims and the above remarks, it is believed that the claims point out Applicants' patentable contribution. Therefore, favorable reconsideration of the application is requested.

Respectfully submitted,
Hedman and Costigan

Charles A. Muserlian, 19,683
Attorney for Applicant(s)
Tel. # (212) 302 8989

CAM:mlp
Enclosure: Return Receipt Postcard

"EXPRESS MAIL" Mailing Label Number: ED 898642520 US

Date of Deposit: December 7, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" Service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Marie-Louise Pinset

Marie-Louise Pinset